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| 09/944,009      | 08/31/2001  | Daniel J. Reed       | 00-1048             | 9362             |

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[REDACTED] EXAMINER

WEEKS, GLORIA R

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3721

DATE MAILED: 12/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                            |                           |
|------------------------------|----------------------------|---------------------------|
| <b>Office Action Summary</b> | Application No.            | Applicant(s)              |
|                              | 09/944,009                 | REED, DANIEL J. <i>CR</i> |
|                              | Examiner<br>Gloria R Weeks | Art Unit<br>3721          |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 August 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 August 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> | 6) <input type="checkbox"/> Other: _____                                    |

*Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "112" has been used to designate both the locking ball and a spring in figure 4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "hammer device" in line 13. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Doberne (USPN 3,602,419).

In reference to claim 1, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool, the hammer tool having a housing with a barrel portion including a rear section and a nose section, the hammer having a reciprocating impact member (12), the adapter comprising: a shroud (19) for removably mounting on the hammer tool (11), having a bore (45) formed through the upper shroud between a forward and rearward end, the rearward end of the shroud removably receiving a portion of the hammer device; a drive punch (27) positioned in the bore (45) of the shroud (19) with a rear section for being impacted by the reciprocating impact member (12) and a forward end (22) for impacting an object (25) to be driven; and a guide bushing (18) extending forwardly from the shroud (19), having a forward and rearward end, a channel (20) extending through the guide busing (18) between the forward and rearward ends for receiving a portion of the object (25) to be driven, the guide bushing (18) being slidably mounted (figures 2-3) on the front portion of the shroud (19) such that the guide bushing (18) is movable between an extended position (figure 2) and a retracted position (figure 3).

Regarding claim 2 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein a lip (32, 35) is formed on the front portion of the shroud (19) and extends inwardly into the bore (45), and an annular flange (33, 34) extends radially outward from the guide bushing (18) for retaining the guide bushing (18) on the shroud (19).

With respect to claim 3 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool additionally comprising an annular groove formed in an interior surface (16) of the bore (45) and a securing ring (40) removably mounted in the annular groove in the bore (45).

In reference to claim 4 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool additionally comprising a biasing means (31) for biasing the guide bushing (18) into an extended position (figure 2) with respect to the shroud (19).

Regarding claim 5 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the biasing means (31) comprises a compression spring positioned in the bore (45) for pushing the guide bushing (18) in a forward direction (figure 2).

With respect to claim 6 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein an annular punch flange (28) extends radially outwardly from the drive punch (27), the punch flange (28) being positioned generally between the front and rear section of the drive punch (27).

In reference to claim 11 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the rear portion of the shroud (19) includes retaining means (17) for retaining the shroud (19) on the nose of the hammer tool (11).

In reference to claim 14 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein an interior surface of the bore at the rear portion has threads (17) formed thereon for threadedly engaging exterior threads in order to attach the shroud (19) to the hammer tool (11).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3721

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419).

In reference to claim 7 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the shroud (19) has an outer surface, the outer surface of the shroud having a substantially cylindrical front and rear part. Doberne does not disclose the shroud (19) including a frusta-conical intermediate part. It would have been an obvious matter of design choice to have a shroud with a frusta-conical intermediate part, since applicant has not disclosed that this specific shape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with shroud with a solid cylindrical shape.

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Gupta (USPN 4,139,137).

Regarding claim 8 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool but does not disclose

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Steigauf (USPN 4,519,536).

With respect to claim 10 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool additionally comprising a guide bushing (18), but does not disclose magnetic member mounted on the guide bushing (18). Steigauf teaches an adapter (26) for converting a hammer tool into a multiple-impact object driving tool

including a magnetic member mounted on the guide bushing (26; column 1, lines 30-36 and 52-54).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guide bushing of Doberne to include the magnetic member of Steigauf for the purpose of holding an object (25) to be driven in the guide bushing.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of York (USPN 4,030,654).

Regarding claim 12 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the retaining means (17) for the shroud onto the hammer tool includes threads. York discloses a hammer tool with retaining means including: a longitudinal slit formed in attachment means (figure 2) and extending from the rearward end of the attachment toward the forward end; and a pair of retaining tabs, each of the retaining tabs being mounted on the rear portion on a side of the longitudinal slit such that the retaining tabs are located on opposite sides of the longitudinal slit; and a fastener (34) for constricting the longitudinal slit by pulling the retaining tabs toward each other (figures 2-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retaining means of Doberne to that of York, since there are various known means of fastening or retaining an attachment.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Dudek (USPN 3,734,515).

Regarding claim 13 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the retaining means (17) for the shroud (19) onto the hammer tool (11) includes threads. Dudek discloses tool with retaining means including: a recess (64) formed in a portion of the shroud (48), the recess (64)

extending between a bore in the shroud and an exterior of the shroud; a locking ball (62) positioned in the recess (64) and being movable in the recess (64) between a locked position in which the locking ball (62) extends into the bore (64) for engaging an exterior of a nose section (60) of the tool, and an unlocked position in which the locking ball (62) is substantially completely retracted into the recess (64); a lever (70) movably positioned in the recess (64), the lever (70) having a locked position in which the lever (70) presses the locking ball (62) into the locked position and an unlocked position in which the lever permits the locking ball to retract into the recess (column 3, lines 7-27) It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retaining means of Doberne to include the retaining means of Dudek since there are various known means of fastening or retaining an attachment.

12. Claims 15-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Mizuno et al. (USPN 4,404,877).

Regarding claim 15 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool but does not disclose an extender assembly. Mizuno et al. teaches a tool comprising an extender assembly removably mounted on the shroud (1), the extender assembly including an extender member (20) extending forwardly past the forward end of the shroud (1) and the forward end of the guide bushing (10), a foremost end (22) of the extender member (20) having a forked configuration for receiving a portion of a fastener to position the fastener as it extends into the channel of the guide bushing (column 3, lines 40-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hammer tool of Doberne to include the extender member of Mizuno et al. for providing additional guidance to the fastener as the fastener is hammered into the workpiece.

With respect to claim 16 and its limitations as stated above, the modified apparatus of Doberne in view of Mizuno et al. discloses an adapter with an extender member wherein the extender member (Mizuno et al.-20) has two telescopic portions (Mizuno et al.-column 3, lines 48-57; figure 4) permitting adjustment of the amount of forward extension of the foremost end of the extender member (Mizuno et al.-20).

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Gupta (USPN 4,139,137) and Steigauf (USPN 4,519,536).

In reference to claim 17, Doberne in view of Gupta and Steigauf discloses an adapter for converting a hammer tool into a multiple-impact object driving tool as disclosed in the combination of the rejections made above.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Mizuno et al. (USPN 4,404,877) as applied to claim 15 above, and further in view of Dudek (USPN 3,734,515).

Regarding claim 13 and its limitations as stated above, the modified apparatus of Doberne in view of Mizuno et al. discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the retaining means (Doberne-17) for the shroud (Doberne-19) onto the hammer tool (Doberne-11) includes threads. Dudek discloses tool with retaining means including: a recess (64) formed in a portion of the shroud (48), the recess (64) extending between a bore in the shroud and an exterior of the shroud; a locking ball (62) positioned in the recess (64) and being movable in the recess (64) between a locked position in which the locking ball (62) extends into the bore (64) for engaging an exterior of a nose section (60) of the tool, and an unlocked position in which the locking ball (62) is substantially completely retracted into the recess (64); a lever (70) movably positioned in the recess (64), the lever (70) having a locked position in which the lever

(70) presses the locking ball (62) into the locked position and an unlocked position in which the lever permits the locking ball to retract into the recess (column 3, lines 7-27) It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retaining means of Doberne to include the retaining means of Dudek since there are various known means of fastening or retaining an attachment.

15. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Mizuno et al. (USPN 4,404,877) as applied to claim 15 above, and further in view of York (USPN 4,030,654).

Regarding claim 12 and its limitations as stated above, the modified apparatus of Doberne in view of Mizuno et al. discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the retaining means (Doberne-17) for the shroud onto the hammer tool includes threads. York discloses a hammer tool with retaining means including: a longitudinal slit formed in attachment means (figure 2) and extending from the rearward end of the attachment toward the forward end; and a pair of retaining tabs, each of the retaining tabs being mounted on the rear portion on a side of the longitudinal slit such that the retaining tabs are located on opposite sides of the longitudinal slit; and a fastener (34) for constricting the longitudinal slit by pulling the retaining tabs toward each other (figures 2-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the retaining means of Doberne to that of York, since there are various known means of fastening or retaining an attachment.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R Weeks whose telephone number is (703) 605-4211. The examiner can normally be reached on 9:30 am - 8:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (703) 305-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7769 for regular communications and (703) 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1789.

Gloria R Weeks  
Examiner  
Art Unit 3721

*GRW*  
grw  
November 27, 2002



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